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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,132	07/20/2004	Gerhard Schmaus	3968-120	1516
30448	7590	11/04/2008		
AKERMAN SENTERFITT				
P.O. BOX 3188				
WEST PALM BEACH, FL 33402-3188				
EXAMINER				
CHONG, YONG SOO				
ART UNIT		PAPER NUMBER		
1617				
MAIL DATE		DELIVERY MODE		
11/04/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/502,132

Applicant(s)

SCHMAUS ET AL.

Examiner

YONG S. CHONG

Art Unit

1617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-5, 7-11, 18 and 20-23 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 12-17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 8/8/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's arguments filed on 8/8/08. Claim 6 has been cancelled. Claims 22-23 have been added. Claims 1-5, 7-23 are pending. Claims 1, 4-5, 7-11 have been amended. Claims 1-5, 7-23 are examined herein.

Applicant's arguments, new claim amendments, and the Schmaus Declaration filed on 8/8/08 have been fully considered and found persuasive to withdraw the 103(a) rejections of the last Office Action. The following new rejections will now apply.

Claim Objections

Claim 4 is objected to because of the following informalities:

The term "1,2-alkandiols" is misspelled and should be replaced with "1,2-alkanediols". Appropriate correction is required.

Claim 8 is objected to because of the following informalities:

The term "1,2 alkanediols" should be spelled with a hyphen in order to be consistent throughout the claim set. Appropriate correction is required.

Claims 12-17, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 9 recites the limitation "alkanediol mixture" in claim 1. There is insufficient antecedent basis for this limitation in claim 1, since claim 1 recites specifically "1,2-alkanediols".

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-8, 10-11, 18, 20-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 12-13 of copending Application No. 11/254,346. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

referenced claims recite an antimicrobial composition comprising at least two unbranched 1,2-alkanediols having between 5 to 10 carbons along with a preservative, whereas the instant claims recite a composition comprising mixing two or more unbranched 1,2-alkanediols of different chain length between 5 to 10 carbons along with a preservative. Both sets of claims are obvious variations of one another since both claim a composition comprising two or more unbranched 1,2-alkanediols of different chain length between 5 to 10 carbons with a preservative.

Claims 1-5, 7-10, 20-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 11/460,587. Although the conflicting claims are not identical, they are not patentably distinct from each other because the referenced claims recite an antimicrobial composition comprising at least two unbranched 1,2-alkanediols having between 6 to 12 carbons and a compound of formula I, whereas the instant claims recite a composition comprising mixing two or more unbranched 1,2-alkanediols of different chain length between 5 to 10 carbons. Both sets of claims are obvious variations of one another since both claim a composition comprising two or more unbranched 1,2-alkanediols of different chain length between 5 to 10 carbons.

Claims 1-5, 7-8, 20-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 11/721,113. Although the conflicting claims are not

identical, they are not patentably distinct from each other because the referenced claims recite a method of preparing a skin moisture-regulating composition comprising mixing two or more unbranched 1,2-alkanediols of different chain length between 5 to 10 carbons, whereas the instant claims recite a composition comprising mixing two or more unbranched 1,2-alkanediols of different chain length between 5 to 10 carbons. Both sets of claims are obvious variations of one another since both claim a composition comprising two or more unbranched 1,2-alkanediols of different chain length between 5 to 10 carbons.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong S Chong/
Examiner, Art Unit 1617

YSC